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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,554	12/14/2001	Scott Hamilton	52493.000204	6014
21967	7590	10/22/2003	EXAMINER	
HUNTON & WILLIAMS INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			LAU, TUNG S	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/014,554	HAMILTON ET AL.
	Examiner Tung S Lau	Art Unit 2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 October 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-43 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,5-10,12-22 and 41-43 is/are rejected.

7) Claim(s) 4, 11 and 23-40 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                    6) Other: \_\_\_\_\_ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 1, 7, 20, 2, 3, 5, 6, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 21, 22, 41, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fodor (U.S. Patent Application 2001/0032245) in view of Gainey et al. (U.S. Patent Application 2002/0099681).

Regarding claim 1:

Fodor discloses in a document delivery system which includes a document system for producing document data, system for determining whether a requested document is designated for electronic delivery or non-electronic delivery based on a stored document delivery designation (page 1, section 0009-0010), and a failed email management system which is configured to receive a notice of a failed email delivery and to change a document delivery designation for at least the intended recipient of the failed email, a method of monitoring the electronic delivery of documents (abstract), said method comprising the steps of: creating log files for storing selected data related to selected electronic document preparation and delivery events (page 1, section 009-0010) ; forwarding said log

files to a parsing engine (page 2, section 0024-025); parsing said log files to retrieve selected data; and storing the retrieved selected data for retrieval and analysis (page 3-4, section 0033).

Regarding claim 7:

Fodor discloses a system for monitoring the electronic delivery of documents, said system comprising a document system, said document system producing document information for printing documents (abstract); wherein said system management system determines whether a requested document is designated for electronic delivery or non-electronic delivery; a recipient database (fig. 1), wherein said recipient database stores recipient information (fig. 2, unit 100), 102); wherein system is configured to receive documents designated for non-electronic delivery (fig. 2, unit 102); an email system (fig. 1, 2), said email system configured to accept and process document data for creating and delivering documents electronically (fig. 2, unit 100, 102, 104); a failed email management system (fig. 2, unit 110, 142), wherein said failed email management system is configured to receive a notice of a failed email delivery including a failed email address (page 3-4, section 0033), and to change a document delivery designation for at least the intended recipient of the failed email (page 3-4, section 0033); and an electronic monitoring system for creating and storing log files containing data related to selected document delivery events (page 3-4, section 0033-0035).

Regarding claim 20:

Fodor discloses a method for electronically delivering documents, said method comprising the steps of producing document data; accepting requests to send selected documents (abstract); determining whether a selected document is accepted for electronic delivery or for non-electronic delivery (fig. 2, unit 114, 110); documents accepted for non-electronic delivery; storing documents and document data for documents accepted for electronic delivery (page 1, section 0009-0010); providing Internet access to the documents and document data accepted for electronic delivery (fig. 1); providing notice regarding the status and availability of said stored documents and document data to intended document recipients (page 2-3, section 0024); detecting the failed delivery of notices to intended notice recipients (page 3-4, section 0033); and creating log files containing system data related to selected electronic document preparation events (page 3-4, section 0033), parsing said log files to retrieve system data; and storing the retrieved system data for later retrieval and analysis )page 4, section 0034-0035).

Regarding claim 41:

Fodor discloses a document delivery system which includes a document system for producing document data and document print requests (abstract).

Regarding claim 42:

Fodor discloses a system for monitoring the electronic delivery of documents, the system comprising a document system, the document system producing document information for printing documents; a recipient database, wherein the recipient database stores recipient information; the email system configured to accept and process document data for creating and delivering documents electronically (fig. 4, page 1, section 0009).

Regarding claim 43:

Fodor discloses a method for electronically delivering documents, the method comprising the steps of producing document data (abstract); determining whether a selected document is accepted for electronic delivery or for non electronic delivery (fig. 7, 4, page 1, section 0009); storing documents and document data for documents accepted for electronic delivery (fig. 7); providing Internet access to the documents and document data accepted for electronic delivery (fig. 3); providing notice regarding the status and availability of the stored documents and document data to intended document recipients (fig. 2).

Regarding claims 2, 3, 5, 6, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 21, 22:

Fodor discloses the log files is stored in the restricted database (fig. 1, unit 19), the log files is created within the email system (fig. 2, unit 124), include the

identification of the email notification client (page 3-4, section 0033), included internet server (abstract), the electronic monitoring system further comprises a parsing engine which parses the log files into retrievable data which is then stored for later retrieval and analysis (page 3-4, section 0033). The log files is created within the recipient database, internet server (page 3-4, section 0033, fig. 1, unit 19), data and time of accessing the server (fig. 4, unit 208), one document deliver option (fig. 1, unit 10, 13, 19).

Fodor does not disclose a use of a print management system, a non electronically delivery, Gainey discloses a use of a print management system, a non electronically delivery (page 4, section 0055), in order to send a recipients a hardcopy of the system response (page 1, section 0006).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fodor to have the use of a print management system taught by Gainey in order to send a recipients a hardcopy of the system response (page 1, section 0006).

### ***Claim Objections***

2. Claims 4, 11 and 23-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitation of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: prior art fail to teach the system of wherein the data stored includes at least: the file names of documents printed, the number of documents printed or the date and time the documents are printed, a preferred document option is stored for each document recipient, the combination of multiple electronic notices for delivering a single recipient at one time, multiple recipients are changed together based upon common identifying criteria.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

3. Applicant's arguments filed 10/6/2003 have been fully considered but they are not persuasive.

A. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to

one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Fodor and Gainey are in the same field of invention; and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fodor to have the use of a print management system taught by Gainey in order to send a recipients a hardcopy of the system response (page 1, section 0006).

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allowed. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung S Lau whose telephone number is 703-305-3309. The examiner can normally be reached on M-F 9-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 703-308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5841 for regular communications and 703-308-5841 for After Final communications.

Art Unit: 2863

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

TC2800 RightFAX Telephone Numbers : TC2800 Official Before-Final RightFAX - (703) 872-9318, TC2800 Official After-Final RightFAX - (703) 872-9319

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